

REMARKS

STATUS OF THE CLAIMS

Pending independent claims 38 and 39 have been amended to clarify certain claim elements and to include a clamp assembly. *See, independent claim 38 (“a clamp assembly, said connecting member engaging a clamp assembly adapted to selectively and securely engage the remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position, and to be removably engagable to said remote supporting structure”.)*

Newly presented independent claims 40 and 46 have been added that include the recitations of independent claims 38 and 39, as amended, and the recitations of pending dependent claims 2, 3, 5, and 37 and, in addition, further recitations drawn from the disclosure of the specification.

Claim 50 is newly added.

THE OFFICE ACTION

In the Office Action of May 4, 2009, the Office

1. withdrew the rejection of claims 2-16, 20-35, and 37-41 on the basis of 35 U.S.C. § 112, second paragraph, in the previous Office Action as moot in view of the new grounds of rejection and
2. rejected
 - a. claims 2-16, 20-35, 37, 38, 40, and 41 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,493,206 to Albro (“Albro”) and

b. claims 2-16, 20-35, and 37-41 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,246,557 to Walters (“Walters”).

ANTICIPATION BY ALBRO

THE OFFICE HAS NOT REJECTED CLAIMS 2-16, 20-35, 37, 39, 40, AND 41.

The Office rejects claims 2-16, 20-35, 37, 38, 39, 40, and 41 by stating that

In regards to claims 2-16, 20-35, 37, 38, 40 and 41, Albro discloses a combination of a coupling member (10), an electrical wire-carrying conduit (p), and a connecting member (15) for positioning and securing said conduit to a remote supporting structure, said combination comprising:

an said electrical wire-carrying conduit having opposite ends; a said coupling member receiving and supporting said conduit, said coupling member comprises a tubular member having a longitudinal axis and at least one end, said end receiving one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture adapted to face the remote supporting structure; and

said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member, the opposite end of said connecting member extending outwardly beyond said wall and adapted to securely engage the remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position.

Office Action, page 2.

Except for the addition of the drawing element numbers (10, p, and 15) and the use of the indefinite article before “said electrical wire-carrying conduit” and “said coupling member”, this is the exact language of independent claim 38. Consequently, Albro has not been applied to any other claim.

Albro has not been applied against independent claim 39. Therefore, the Office has conceded that independent claim 39 is not anticipated by Albro . Significantly, independent claim 39 is not listed by the Office as being rejected on Albro.

Albro has not been applied against the remaining dependent claims, 2-16, 20-35, 37, 40, and 41. Therefore, the Office has conceded that dependent claims 2-16, 20-35, 37, 39, 40, and 41 are not anticipated by Albro.

THE REJECTION IS NOT COMPLIANT WITH 35 U.S.C. 132 AND 37 C.F.R. 1.104(c)(2).

Section 132 (35 U.S.C.A. 132) requires that

35 U.S.C. 132 Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Rule 104(c)(2) (37 C.F.R. 1.104(c)(2)) requires that

(c) *Rejection of claims.*

* * * * *

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim is not compliant with either the statute or the rules. While the Office has stated its conclusion, it has not given any supporting reasoning.

Applicant's device allows connectors at any convenient position along the supporting structure, such as a ceiling beam. The prior art required constructing a separate fixedly and precisely positioned supporting structure, a threaded holder, fixed to the beam of ceiling. Such a holder requires its construction only after the conduit and coupling member is positioned to know where to place the holder. Also, the prior art structures require at least two persons to position, one to hold the conduit and the other to align and fix the holder. The device disclosed in this application requires only one (1) person to fix the clamp to the beam anywhere along its length, convenient to the conduit to be supported.

None of these advantages are obtainable with the cited art.

THE OFFICE HAS NOT ESTABLISHED A PRIMA FACIE CASE OF ANTICIPATION BY ALBRO.

In order to establish a *prima facie* case of anticipation, each and every element in the claim must be found in the reference. *See*, MPEP ¶ 2131 as follows:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM
"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim does not establish a *prima facie* case of anticipation.

ALBRO DOES NOT ANTICIPATE CLAIM 38.

Applicant submits that Albro does not anticipate for at least the basis that Albro discloses an adjustable pipe hanger. Albro states

Referring first to FIG. 3, a split cradle member 10 which, for example, may be formed of a plastic material such as Type 1 polyvinyl chloride, is provided with an inner diameter which when the hanger is installed to support pipe P will afford a suitable clearance for such pipe.

The cradle member 10 is not a coupling member. A cradle is not a coupling. *See*, McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition (1978), as follows:

Cradle. [ENG] A framework or resting place for the supporting or restraining objects.

McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition (1978), page 375.

Coupling. [ENG] Any device that serves to connect the ends of adjacent parts, as railroad cars.

McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition (1978), page 373.

ANTICIPATION BY WALTERS

THE OFFICE HAS NOT REJECTED CLAIMS 2-16, 20-35, 37, 39, 40, AND 41.

The Office rejects claims 2-16, 20-35, and 37- 41 by stating that

In regards to claims 2-16, 20-35, and 37-41, Walters discloses a combination of a coupling member (7), an electrical wire-carrying

conduit (2,2'), and a connecting member (25) for positioning and securing said conduit to a remote supporting structure, said combination comprising:

an said electrical wire-carrying conduit having opposite ends;

said coupling member receiving and supporting said conduit, said coupling member comprises a tubular member having a longitudinal axis and at least one end, said end receiving one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture adapted to face the remote supporting structure; and

said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member, the opposite end of said connecting member extending outwardly beyond said wall and adapted to securely engage the remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position.

Office Action, page 2.

Except for the addition of the drawing element numbers (7, 2, 2', and 25) and the use of the indefinite article before "said electrical wire-carrying conduit", this is the exact language of independent claim 38.

Walters has not been applied against independent claim 39. Therefore, Applicant respectfully submits that the Office has conceded that independent claim 39 is not anticipated by Walters.

Walters has not been applied against the remaining dependent claims, 2-16, 20-35, 37, 40, and 41. Therefore, Applicant respectfully submits that the Office has conceded that dependent claims 2-16, 20-35, 37, 39, 40, and 41 are not anticipated by Walters.

THE REJECTION IS NOT COMPLIANT WITH 35 U.S.C. 132 AND 37 C.F.R. 1.104(C)(2).

Section 132 (35 U.S.C.A. 132) requires that

35 U.S.C. 132 Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected,

or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Rule 104(c)(2) (37 C.F.R. 1.104(c)(2)) requires that

(c) Rejection of claims.

* * * * *

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim is not compliant with either the statute or the rules. While the Office has stated its conclusion, it has not given any supporting reasoning.

THE OFFICE HAS NOT ESTABLISHED A PRIMA FACIE CASE OF ANTICIPATION BY WALTERS.

In order to establish a *prima facie* case of anticipation, each and every element in the claim must be found in the reference. *See*, MPEP ¶ 2131 as follows:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM
"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim does not establish a *prima facie* case of anticipation.

WALTERS DOES NOT ANTICIPATE CLAIMS 2-16, 20-35, 37, 39, 40, AND 41.

Applicant submits that Walters does not anticipate for at least the basis that Walters discloses an adjustable pipe hanger that does not provide “a clamp assembly adapted to selectively and securely engage the remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position, and to be removably engagable to said remote supporting structure” (independent claims 38, 39, 42, and 46.) In this respect Walters lacks a clamp assembly, *inter alia*. In addition, newly presented independent claims 40 and 46 include the recitations of independent claims 38 and 39, as amended, and the recitations of pending dependent claims 2, 3, 5, and 37 and, in addition, further recitations drawn from the disclosure of the specification.

For the reasons discussed above with respect to the rejection of Albro, similarly here, Walters does not teach the structure disclosed and claimed.

CONCLUSION

By virtue of the foregoing amendments to the claims and remarks, Applicant submits that all outstanding grounds of rejection have been addressed and dealt with and, based thereon, submits that the application is now in condition for allowance and such action is respectfully solicited. Specifically, claims 2-16, 20-35, 37, 39, 40, and 41 are allowable because they have not been rejected. And claim 38 is allowable since it is not anticipated by either Albro or Walters for the reasons stated. Further, new claims 42 – 49 are patentable over Albro and Walters.

Respectfully submitted,

Howard C. Miskin

Howard C. Miskin, Esq.
Reg. No. 18,999
Attorney for Applicant
Of Counsel
MISKIN & TSUI-YIP, LLP
1350 Broadway, Suite 802
New York, NY 10118
(212) 268-0900